



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/411,075	10/04/1999	PRAMOD K. SRIVASTAVA	8449-054-999	7824

7590 08/26/2002
PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

DAVIS, KATHARINE F

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 08/26/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/411,075

Applicant(s)

SRIVASTAVA, PRAMOD K.

Examiner

Katharine F. Davis

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51,55-60,63-71 and 77-111 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 56-60,63-71,77,78,80,86-92,94,96 and 98-102 is/are rejected.

- 7) ☒ Claim(s) 51,55,79,81-85,93,95,97 and 103-111 is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)

- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

- 5) ☐ Notice of Informal Patent Application (PTO-152)

- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after **allowance** or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on May 22, 2002 has been entered.

New claims 103-111 have been added. Claims 51, 55-60, 63-71 and 77-111 are pending in the instant application.

Priority

The status of the provisional application (60/103,115) to which the instant application claims priority should be updated in the first paragraph of the specification at page 1.

Information Disclosure Statement

The following is noted with regard to the IDS filed on April 6, 2000: References BO-BT on page 3 have been considered by the examiner however the hyperlinks have been crossed out on the 1449 form because hyperlinks or other forms of browser-executable codes are not permitted in the disclosure, see MPEP 608.01. All references that are initialed and not crossed out on a 1449 form will be printed on the front page of a patent which will issue from an application thus hyperlinks can not be cited on a 1449 form since the citations become part of the disclosure.

Claim Objections

Claims 51, 56, 79-84, 103 and 111 are objected to because of the following informalities:

Claims 51, 56, 79-84 and 103 recite the term "heat shock receptor". It is suggested that the term be amended to "heat shock **protein** receptor" throughout the claims for clarity. Claim 111 recites the phrase "purified away from". It is suggested that the word "away" be deleted from this claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 56-60, 63-71, 77, 78, 80, 86-92, 94, 96 and 98-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 56 recites the term "the small molecule" in line 11. There is insufficient antecedent basis for this term in the claims.

Claims 57 and 60 appear to be identical with regard to further limitation of claim 51. It is unclear what applicants intend with this duplication.

Claim 68 recites the term "the molecule". There is insufficient antecedent basis for this term in the claims.

Claim 80 recites the phrase "against the peptide". There is insufficient antecedent basis for this phrase in the claims.


Claims 86, 87, 90 and 101 further limit the method of claim 79, 81, 82, or 84 and each recite the phrase "wherein the molecule". However claims 79 and 82 are drawn to methods for screening a plurality of molecules.

Conclusion

Claims 56-60, 63-71, 77, 78, 80, 86-92, 94, 96 and 98-102 are rejected. Claims 51, 55, 79, 81-85, 93, 95, 97 and 103-111 are objected to for minor informalities. Claims 51, 55-60, 63-71 and 77-111 are free of the prior art as the prior art does not disclose or suggest screening methods using a heat shock protein receptor such as the methods claimed in the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katharine F. Davis whose telephone number is (703) 605-1195 with direct desktop RightFax (703) 746-5199. The examiner can normally be reached on Monday-Friday (8:30am-5:00pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications. Any inquiry of a general nature or any inquiry concerning the formalities of this application should be directed to Patent Analyst Tracey Johnson whose telephone number is (703) 305-2982.

Katharine F. Davis
August 26, 2002


REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600